

REMARKS

Claims 1-8 are all the claims pending in the application.

I. Response to Rejection of Claims 1-2 and 6 under 35 U.S.C. § 102(e)

The rejection of claims 1-2 and 6 under 35 U.S.C. §102(e) as allegedly being anticipated by Ohno et al. (US App 2003/0054201) has been maintained for the reasons of record.

Applicant respectfully traverses the rejection and submits that Ohno does not anticipate the present invention.

The Examiner takes the position that Ohno states that "all or part of the additives used in the present invention may be added to a magnetic coating solution at any stage of its preparation" at [0070], and that Ohno goes on further to state that the additive may be blended with the ferromagnetic powder before a kneading step.

In [0070], Ohno states:

All or a part of the additives used in the present invention may be added to a magnetic coating solution at any stage of its preparation. For example, an additive may be blended with a ferromagnetic powder before a kneading step; it may be added during the kneading step involving the ferromagnetic powder, a binder, and a solvent; it may be added during a dispersing step; it may be added after the dispersing step; or it may be added immediately before coating.

The Examiner's reliance upon the above disclosure to support his position that Ohno teaches premixing of a magnetic material (e.g., ferromagnetic powder) with a solvent before adding a binder, as required by claims 1 and 6, appears to be misplaced.

First, [0071] states that "all or part of the additives". Ohno discloses that an additive has a lubricating effect, an antistatic effect, a dispersing effect, a plasticizing effect, etc. in [0067], and does not disclose a "solvent" as an additive. In this regard, in [0080], Ohno discloses that "the magnetic coating solution is prepared by kneading and dispersing a

ferromagnetic powder, a binder, carbon black, an abrasive, an antistatic agent, a lubricant, etc., usually with a solvent.” Thus, Ohno teaches that a solvent is different from an additive, such as an antistatic agent, a lubricant, etc.

Second, [0071] states that “a kneading step; it may be added during the kneading step involving the ferromagnetic powder, a binder, and a solvent”. The use of “the” before the second “kneading step” indicates that the “kneading step” is equivalent to the first kneading step. Accordingly, [0071] discloses that an additive (which does not include a solvent) can be added to a ferromagnetic powder before kneading the ferromagnetic powder, binder and solvent together. Therefore, [0071] does not appear to support the Examiner’s position that Ohno teaches a mixture of a ferromagnetic powder and a solvent, which is initially separate from a binder.

In addition, throughout the disclosure, Ohno teaches mixing/kneading a magnetic material, binder and solvent together. For example, in [0027], Ohno discloses that when preparing a magnetic coating solution, kneading of a magnetic material, a binder and a small amount of solvent is generally carried out with a strong shear force by means of a device such as a kneader. Also, in the Examples of Ohno, a vinyl chloride based resin (binder) and methyl ethyl ketone/cyclohexanone (solvent) were added to a kneader containing ferromagnetic metal powder.

In view of the above, there is no disclosure in Ohno directed to a mixture of a ferromagnetic powder and a solvent, which is initially separate from a binder.

Accordingly, Ohno does not disclose the present invention according to claims 1 and 6, which require a liquid A comprising a ferromagnetic powder and a solvent, which is separate

from solution B of a binder.

Further, each of claims 1-2 depend directly from claim 1. Thus, it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1.

In view of the above, withdrawal of the rejection is respectfully requested.

II. Response to Rejection of claims 3-5 and 7-8 under 35 U.S.C. § 103(a)

The rejection of claim 3 under 35 U.S.C. §103(a) as allegedly being unpatentable over Ohno et al. in view of Hall et al.; claims 4 and 7 under 35 U.S.C. §103(a) as allegedly being unpatentable over Ohno et al. in view of Ikeuchi et al. and claims 5 and 8 under 35 U.S.C. §103(a) as allegedly being unpatentable over Ohno et al. in view of Akashi et al. have been maintained for the reasons of record.

Applicant respectfully traverses the rejection and submits that the cited references do not render the present invention obvious.

Each of claims 3-5 and 7-8 depend, directly or indirectly, from claims 1 and 6, respectively. Thus, it is respectfully submitted that these claims are patentable for at least the same reasons as claims 1 and 6, discussed above.

In addition, Ohno is a §102(e) reference as of its April 25, 2002 filing date. Since Ohno and the present invention were commonly owned at the time the present invention was made, Ohno is disqualified as a §102(e) reference under 35 U.S.C. § 103(c).

Further, Ohno is a §102(a) reference as of its March 20, 2003 publication date. Accordingly, sworn English translations of the priority documents supporting the elements of the present claims are submitted herewith, thereby removing Ohno as §102(a) art.

In view of the above, Applicant respectfully requests withdrawal of the rejection.

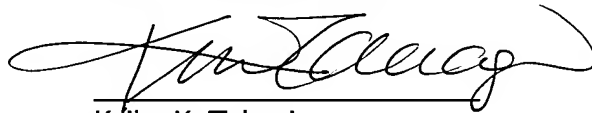
III. Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-8 is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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